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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,753	01/11/2002	Donna Joy Guinn	98500/1098	9674

7590 03/16/2004

KATTEN MUCHIN ZAVIS
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Chicago, IL 60661-3693

EXAMINER

KUMAR, PREETI

ART UNIT PAPER NUMBER

1751

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,753

Applicant(s)

GUINN, DONNA JOY

Examiner

Preeti Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Non-Final Rejection

1. Claims 1-13 are pending.

Response to Arguments

2. The rejection of claims 1-5, 7-11 under 35 U.S.C. 102(b) as being anticipated by Caldwell (US 5,004,643) is withdrawn in light of applicants remarks.
3. The rejection of claims 6, and 12-13 under 35 U.S.C. 103(a) as being unpatentable over Caldwell (US 5,004,643) as applied to claims 1, 3-5, 7 and 9-11 above is withdrawn in light of applicants remarks.
4. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

New Grounds of Rejection

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 5, 7 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kneip et al. (US 5,702,490).

Kneip et al. teach treatment of leather and skins for water repellency in aqueous emulsion in the presence of emulsifiers with polysiloxanes which are functionalized with carboxyl groups. See abstract. Kneip et al. teach that the water repellent agent contains from 3 to 90% by weight of polysiloxanes functionalized with carboxyl groups in a comb-like manner, from 3 to 30% by weight of emulsifiers and from 0 to 50% by weight of paraffins, liquid paraffins or white oils, mineral oils, natural fats or natural oils or synthetic or natural waxes, the percentages being based on the amount of aqueous emulsion. See col.4, ln.30-40. Kneip et al. teach that the use of the polysiloxanes functionalized with carboxyl groups described, the finishing, ie. surface treatment of the leathers, is influenced only to an imperceptible extent, since the polysiloxane is more readily distributed in the leather cross-section. See col.4, ln.65-col.5, ln.5.

Kneip et al. illustrate functionalized polysiloxane emulsions used to provide water resistance to leather. Please see col.5, ln.30-50 where Kneip et al teach that chrome-tanned side leather (wet blues) was drummed for 90 minutes in a tanning vessel with

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4% by weight of commercial mimosa extract, 4% by weight of a commercial synthetic tanning agent based on phenolsulfonic acid/formaldehyde condensate, 3% by weight of a commercial polymer tanning agent and 2% by weight of a commercial leather dye, the percentages in each case being based on the shaved weight. Drumming was then carried out with 8% by weight, based on the shaved weight, of each of the water repellent emulsions from Example 1 and Example 2 for 90 minutes, and the working liquor of 100% [sic] was acidified to a pH of 3.8 with formic acid, after which washing was carried out. Finally, mineral salt fixation was effected with 3% by weight of a commercial chrome tanning agent for 90 minutes in the tanning vessel. The leathers were washed, mechanically set out and dried. The resulting leathers were soft, had a pleasant handle and could be readily finished. See col.5, ln.30-50.

Accordingly, the broad teachings of Kneip et al. appear to anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Kneip et al. are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art, to arrive at a method of treating a textile or leather with a pre-cured silicone, wiping the excess water and drying the textile or leather as recited by the instant claims because Kneip et al teach a method to provide water resistance to leather wherein the water repellent agent comprises functionalized polysiloxane emulsions and furthermore, Kneip et al. teach that upon treatment with the water repellant agent, the leather were washed and dried.

9. Claims 2-4 and 6 and 8-10, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kneip et al. (US 5,702,490).

Kneip et al. are relied upon as set forth above. Kneip et al. silent as to the specific temperature at which the silicone emulsion is dried. Also, Kneip et al. do not teach the dilution with the specified ratio of water as recited by the instant claims.

However, it would have been obvious, to one of ordinary skill in the art, to dry the silicone emulsion at the broad temperature range encompassed by the material limitations of the instant claims because the teachings of Kneip et al. suggest that that leathers were mechanically set out and dried in general.

Furthermore, it would have been obvious, to one of ordinary skill in the art, to dilute the emulsion with the specified ratio of water as recited by the instant claims because Kneip et al. suggest that the functionalized polysiloxanes be diluted with 3-30% by weight of emulsifiers in general which encompass water-in-oil emulsifiers.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Preeti Kumar
Examiner
Art Unit 1751

PK



MARGARET EINS
PRIMARY EXAMINER
GROUP 1100